

4-03.2000

Advisory Action

Application No.
08/252,710

Applicant(s)

Riviere et al

Examiner
Jeffrey Fredman

Group Art Unit
1655



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Jan 19, 2000 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Mar 29, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
The arguments are directed towards the claims as amended and the amendment was not entered.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: 38-41

Claims objected to: _____

Claims rejected: 1-4, 6-31, 35-37, and 42-44

- ☐ The proposed drawing correction filed on _____ ☐ has. ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

JEFFREY FREDMAN
PRIMARY EXAMINER
ART UNIT 1655

Art Unit: 1655

Response to Amendment

As an initial matter, the Patent Office has not received a copy of the Notice of Appeal which Applicant has kindly indicated will be faxed in prior to the mailing of this Advisory action.

Applicant should also note that new claims dependent from the allowed claims would, assuming they do not introduce new matter, be entered.

With regard to the specific amendment, the new limitation that "Wherein the splice acceptor site is a splice acceptor site necessary for the generation of the env mRNA of a wild type retrovirus" would require further search and consideration and would not simplify the issues. Specifically, the prior searches did not focus on the need to search vectors which incorporated significant elements of the wildtype env gene, because the claims have consistently excluded the env gene in its entirety. So a further search for 103 references which teach the use or suggest the use of wildtype env regions is necessary to properly address the claim. The entire previous cycle of the application dealt with the new matter issue regarding "consensus" and no art rejections were found addressing consensus sequences. The cycle before that did have several art rejections, but the claims in those cycles did not characterize the splice acceptor site in any way. Thus, the new characterization of the splice acceptor site as one necessary for the generation of env mRNA has never been searched in previous cycles of this application and would require further search and consideration.